

21 CV 06983

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
COPYRIGHT INFRINGEMENT, UNFAIR COMPETITION AND RELATED CLAIMS**

Plaintiff, Michael Medina, alleges his complaint against Defendants, Victoria's Secret & Co. ("VS&Co"), and Victoria's Secret Stores Brand Management, LLC ("VSSBM") as follows:

NATURE OF THE ACTION

1. This action arises from Defendant's infringement of Plaintiff's "ownership" and exclusive "use" rights in the mark, **ONPOINT®** in conjunction with clothing, merchandise and other related goods. Despite Plaintiff being the senior user and owner of the trademark **ONPOINT®** and offering various clothing items and merchandise under such brand name, the Defendants have infringed Plaintiff's rights in the aforementioned mark by advertising, selling, and offering for sale a collection of clothing items under Plaintiff's **ONPOINT®** trademark. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Victoria's Secret Defendants named in this action and Plaintiff resulting in the unjust enrichment of Defendant's by using Plaintiff's trademark.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1051 *et seq.*, 15 U.S.C. Sections 1114-1116; under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a), Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c) 17 U.S.C. §101, et. seq., 17 U.S.C. §501-509 and 28 U.S.C. §1367.

3. This Court has personal jurisdiction over the Defendants because Defendants engage in continuous and significant business activities in and directed to the State of New York within this judicial district and because Defendants have committed tortious acts aimed at and causing harm within the State of New York and this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff resides and the Defendants transacts business in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district. Defendants also advertise, market and sell goods in this district via the internet and/or directly via its retail clothing stores.

THE PARTIES

5. Plaintiff, Michael Medina is an individual with an address at 65 Columbia Street – Suite 15K, New York, NY 10002.

6. Upon information and belief, Defendant Victoria's Secret & Co. is a Delaware corporation with a place of business at 1740 Broadway, New York, New York 10019.

7. Upon information and belief, Defendant Victoria's Secret Stores Brand Management, LLC is a Delaware Limited Liability Company with a place of business at 1740 Broadway, New York, New York 10019.

FACTS

8. Since at least as early as 1995, Plaintiff Michael Medina has been selling headwear, t-shirts, sweaters, hooded sweatshirts, sweat pants and other clothing items under the **ONPOINT®** brand name.

9. Since at least as early as April of 1995, Plaintiff has been operating a clothing business under the trade name **ONPOINT CLOTHING INC.** which has sold headwear, t-shirts, sweaters, hooded sweatshirts and other related clothing items under the marks **ONPOINT®**.

10. Plaintiff uses the ® symbol on product packaging materials and on promotional materials to put the public on constructive notice that Plaintiff is claiming trademark rights in the **ONPOINT®** brand name.

11. Plaintiff sells and promotes the sale of his clothing via various retail distribution outlets.

12. Plaintiff's **ONPOINT®** clothing products enjoy a superlative reputation in the apparel industry.

13. Plaintiff is the registered owner of United States Trademark Registration No. 5,598,253 for the mark **ONPOINT®**. (See Exhibit A).

14. Plaintiff was the owner of the corporation that was the registered owner of United States Trademark Registration No. 2,449,760 for the mark **ONPOINT®**. The aforementioned trademark was filed on December 24, 1998 and matured into a trademark registration on May 8, 2001. (See Exhibit B).

15. Plaintiff has built and acquired significant rights in the **ONPOINT®** mark in connection with clothing and merchandise based on Plaintiff's long standing and continuous use

of the mark in commerce in connection with the promotion, sale and offering of clothing items under the aforementioned mark.

16. Upon information and belief, Defendant VS&Co on or about June of 2021 began promoting and offering for sale a collection of clothing items under the mark **ON POINT™**.

17. Defendant VS&Co is marketing, promoting, selling and offering for sale, apparel under Plaintiff's **ONPOINT®** mark which violates Plaintiff's trademark rights in his **ONPOINT®** registration. The aforementioned use in commerce by Defendant VS&Co violates Plaintiff's exclusive use rights in connection with clothing. (**See Exhibit C**)

18. Plaintiff is a senior user of the **ONPOINT®** mark in connection with clothing and has priority rights in the aforementioned mark by virtue of "first use" "in commerce."

19. Upon information and belief, Defendant VS&Co had knowledge of Plaintiff's ownership rights in the **ONPOINT®** mark in connection with the sale and offering of clothing items.

20. Defendant VS&Co use of Plaintiff's trademark has already caused confusion and is likely to continue to cause confusion as to the source of clothing products and other merchandise under the **ONPOINT®** mark.

21. Defendant VS&Co has attempted to secure trademark rights in the mark **ON POINT™** in connection with clothing and similar related and/or competitive clothing goods by filing United States Trademark Serial Application No. 90/803,422 on June 30, 2021. (**See Exhibit D**).

22. Upon information and belief, Defendant VSSBM on or about June of 2021 began promoting and offering for sale a collection of clothing items under the mark **ON POINT™**.

23. Defendant VSSBM is marketing, promoting, selling and offering for sale, apparel under Plaintiff's **ONPOINT®** mark which violates Plaintiff's trademark rights in his **ONPOINT®** registration. The aforementioned use in commerce by Defendant VS&Co violates Plaintiff's exclusive use rights in connection with clothing.

24. Plaintiff is a senior user of the **ONPOINT®** mark in connection with clothing and has priority rights in the aforementioned mark by virtue of "first use" "in commerce."

25. Upon information and belief, Defendant VSSBM had knowledge of Plaintiff's ownership rights in the **ONPOINT®** mark in connection with the sale and offering of clothing items.

26. Defendant VSSBM use of Plaintiff's trademark has already caused confusion and is likely to continue to cause confusion as to the source of clothing products and other merchandise under the **ONPOINT®** mark.

27. Defendant VSSBM has attempted to secure trademark rights in the mark **ON POINT™** in connection with clothing and similar related and/or competitive clothing goods by filing United States Trademark Serial Application No. 90/803,422 on June 30, 2021. (See **Exhibit D**).

FIRST CAUSE OF ACTION
TRADEMARK INFRINGEMENT (15 U.S.C. §§ 1114-1116)

28. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 27 of this Complaint.

29. The use in commerce by Defendants of an identical version of Plaintiff's registered trademark is likely to cause confusion, mistake and deception among members of the public and in trade as to the source, origin, or sponsorship of defendants' goods and services. Such use by Defendants constitutes a clear and direct infringement of Plaintiff's rights in and to

Plaintiff's registered trademark, and has resulted in injury and damage to Plaintiff that will continue if Defendants are not ordered to cease all use of the **ONPOINT®** mark.

SECOND CAUSE OF ACTION

UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a))

30. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 29 of this Complaint.

31. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the **ONPOINT®** mark.

32. Defendants by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendants and Plaintiff's clothing goods and accessories come from one and the same source, and Defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

33. Defendants have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

34. By reason of Defendants willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

35. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 34 of this Complaint.

36. Defendants conduct constitutes deception by which Defendants goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

37. Defendants unauthorized use of Plaintiff's **ONPOINT®** mark is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

38. By reason of the foregoing, Defendants have infringed and continue to infringe on Plaintiff's common law rights in the **ONPOINT®** mark and Defendants have become unjustly enriched by such acts of infringement.

39. Defendants unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights.

FOURTH CAUSE OF ACTION
UNJUST ENRICHMENT

40. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 39 of this Complaint.

41. Defendants have unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's **ONPOINT®** mark.

42. Defendant's actions constitute unjust enrichment.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that all Defendants, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or

entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term **ONPOINT®**, or any colorable imitation thereof; (b) advertising, operating a website, using business stationary or offering any goods or services using the trade name, trademark, domain name, URL, or any other indicia of origin including in whole or part the term **ONPOINT®**, or any colorable imitation thereof; (c) otherwise engaging in any acts of unfair competition and infringement which tend to injure Plaintiff's rights in the **ONPOINT®** mark.

2. That Defendant be required to account to Plaintiff for any and all profits derived by it, and to compensate Plaintiff for all the damages sustained by reason of the acts complained of herein, and that the damages herein be trebled pursuant to the Trademark Act.
3. That Defendant be ordered to deliver up for destruction any and all infringing materials bearing the **ONPOINT®** marks, and any colorable imitation thereof, in whole or part.
4. That Plaintiff be awarded punitive damages against all Defendants.
5. That Defendants be required to place advertisements or send notifications to past and present customers that it improperly has been using the **ONPOINT®** mark.
6. That Plaintiff be awarded statutory damages in the amount of \$1,000,000.00 for Defendants acts of willful infringement of Plaintiff's trademarks.
7. That Plaintiff be awarded the cost and disbursements of this action.
8. That Plaintiff have such other and further relief as the Court deems just and proper.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: August 18, 2021
New York, New York

Respectfully submitted,
Michael Medina – Pro Se



Michael Medina
Pro Se Plaintiff
65 Columbia Street – Suite 15K
New York, New York 10002
(718) 809-4031

EXHIBIT A

United States of America
United States Patent and Trademark Office

ONPOINT

Reg. No. 5,598,253

Medina, Michael (UNITED STATES INDIVIDUAL)

65 Columbia Street - Suite 15k

New York, NEW YORK 10002

Registered Nov. 06, 2018

CLASS 25: Bandanas; Crew neck sweaters; Headgear, namely, hats and caps; Hooded sweat shirts; Short-sleeved or long-sleeved t-shirts; Sweaters; T-shirts; V-neck sweaters

Int. Cl.: 25

FIRST USE 4-00-1995; IN COMMERCE 4-00-1995

Trademark

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 86-379,155, FILED 08-27-2014



Andrea Iannone

Director of the United States
Patent and Trademark Office

EXHIBIT B



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Aug 18 03:17:24 EDT 2021

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#) [PREV LIST](#) [CURR LIST](#) [NEXT LIST](#)
[FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Start : List At: OR Jump : to record: Record 5 out of 5

[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark ONPOINT
Goods and Services (CANCELLED) IC 025. US 022 039. G & S: Clothing, namely, hats, pants, shirts, jackets, T-shirts, underwear, socks, bathing suits, gloves, scarves, footwear, dresses, skirts, pajamas, nightgowns. FIRST USE: 19950400. FIRST USE IN COMMERCE: 19950400
Mark Drawing Code (1) TYPED DRAWING
Serial Number 75611922
Filing Date December 24, 1998
Current Basis 1A
Original Filing Basis 1B
Published for Opposition February 15, 2000
Registration Number 2449760
Registration Date May 8, 2001
Owner (REGISTRANT) Onpoint Clothing, Inc. CORPORATION NEW YORK 549 E. 13th Street New York NEW YORK 10009
Attorney of Record John C. Vassil
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator DEAD

EXHIBIT C

BRAS

PANTIES

SLEEP

LINGERIE

SPORT & LOUNGE

ACCESSORIES

BEAUTY

SWIM

ALL EYES ON NEW

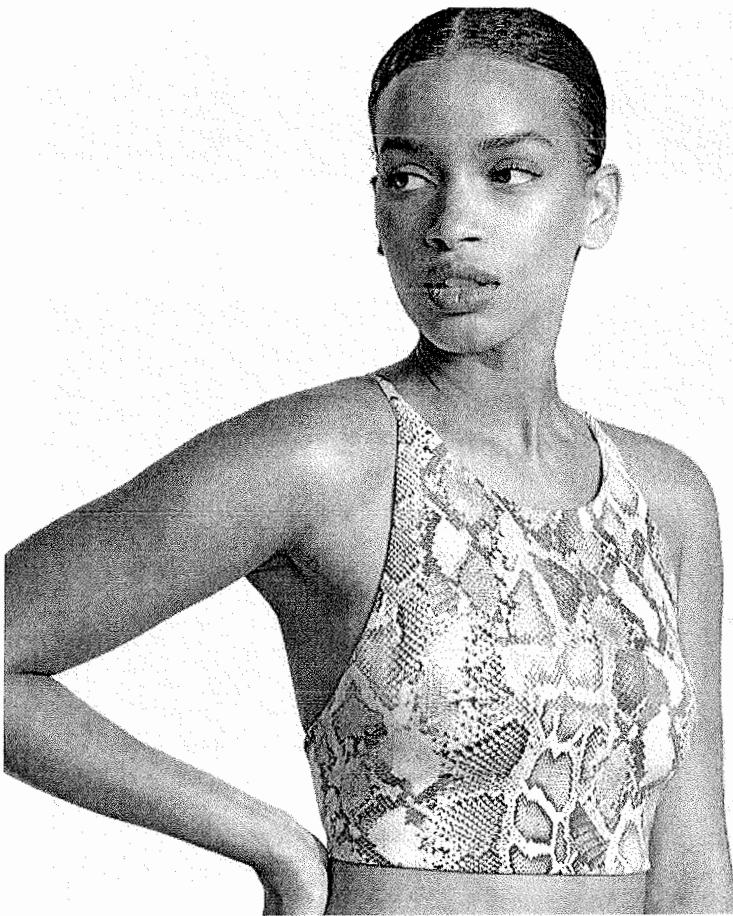
This just in: Bra tops, teddies, sleepshirts, and more.

[SHOP ALL NEW ARRIVALS](#)

THE ON POINT COLLECTION

Whether you're running a marathon or an errand, or perfecting the downward-facing dog, our new leggings and sport bras are tailored to support your every move.

[SHOP THE COLLECTION](#)





NEW! Victoria's Secret Live On Point High Neck Sport Bra
\$39.50

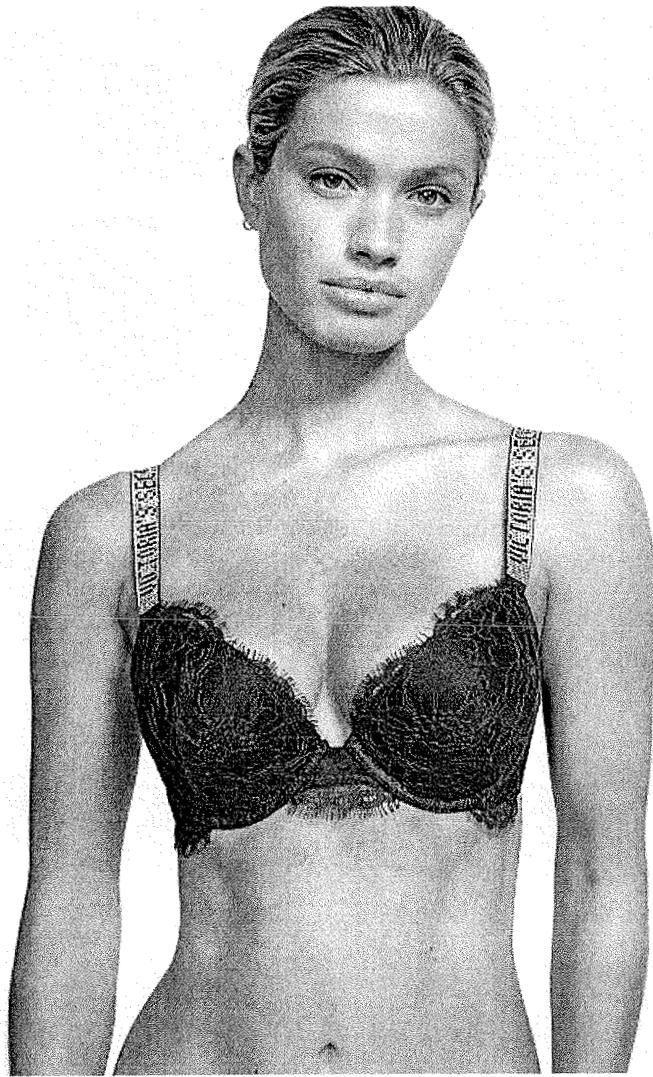


NEW! Victoria's Secret Live On Point Crossover Legging
\$49.50

DETAIL ORIENTED

Discover glamorous extras that make every piece special.

SHOP THE COLLECTION



NEW! Very Sexy Lace Shine Strap Push-Up Bra
★★★★★
\$69.50



NEW! Very Sexy Strappy Lace Cheeky Panty
\$18.50 or any 3/\$36

ENCHANTED GARDEN

Beautiful blooms adorn our most stand-out styles.



English : USD

VICTORIA'S SECRET

Search

NEW! BRAS PANTIES LINGERIE SLEEP SPORT & LOUNGE BEAUTY ACCESSORIES SWIM BRANDS WE LOVE SALE

[◀ Back](#) Victoria's Secret / New! / Live, Love, Sweat /

VICTORIA'S SECRET

Live On Point High Neck Sport Bra

(4.1) > 63 Reviews

\$39.50

1119

Natural Lizard



Size

XS S M L XL

Size & Fit >

- 1 +

ADD TO BAG

 Free returns on all U.S. orders. [Learn More](#)

Find it near you

[Select Store](#)

Description

Whether you're running around town or watching a movie marathon, this style is for you. This ultra-soft made-for-everyday bra was made to move with you all day long.

- Wireless
- Pull-on style
- Hand wash
- Imported
- Removable padding

Composition

Pairs Perfectly With



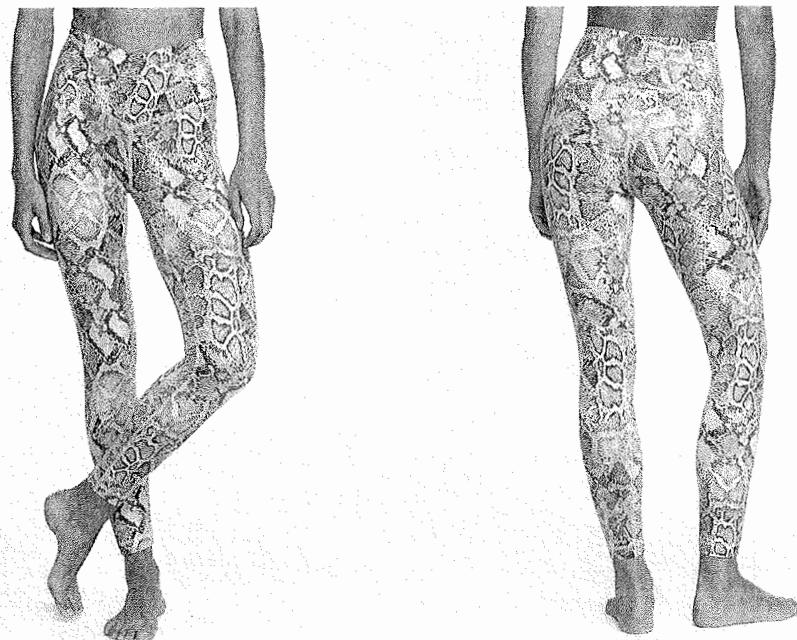
English USD

VICTORIA'S SECRET

Search

NEW! BRAS PANTIES LINGERIE SLEEP SPORT & LOUNGE BEAUTY ACCESSORIES SWIM BRANDS WE LOVE SALE

◀ Back Victoria's Secret / Victoria's Secret Apparel Catalog /



VICTORIA'S SECRET

Live On Point Crossover Legging

★★★★★ (4.7) > 10 Reviews

\$49.50

1119

Natural Lizard



Size

2 4 6 8 10 12 14 16

Size & Fit >

- 1 +

ADD TO BAG

Free returns on all U.S. orders. [Learn More](#)

Find it near you

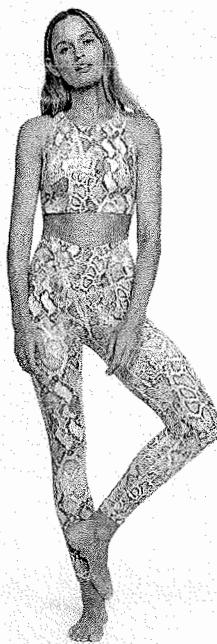
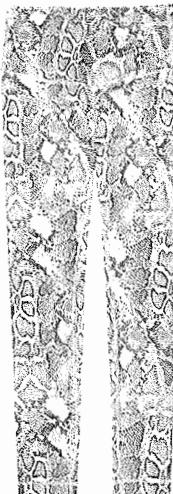
Select St

Description

Made for power lounging and everyday errands. A crossover waistband provides comfort and support while a breathable fabric keeps you cool no matter what.

- High rise
- Cross over waist detail for smoothing comfort support
- Hidden pockets
- Wicking fabric keeps you cool & dry
- 4-way stretch follows your every move
- Machine wash
- Imported

Composition +



Click Image to Enlarge

RATINGS & REVIEWS

INTRODUCING
ON POINT
LIVE FLOW SWEAT

Whether you're running a marathon, an errand, or perfecting that downward-facing dog, our new collection of leggings and sport bras are tailored to support your every move.

EXPLORE THE COLLECTION



EXHIBIT D



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Aug 18 03:17:24 EDT 2021

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#) [PREV LIST](#) [CURR LIST](#) [NEXT LIST](#)
[FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Start | List At: OR Jump to record: Record 13 out of 372

[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

ON POINT

Word Mark ON POINT

Goods and Services IC 025. US 022 039. G & S: Bras; Dresses; Footwear; Hats; Headwear; Hosiery; Leggings; Lingerie; Pajamas; Panties; Pants; Robes; Rompers; Shorts; Skirts; Sleepwear; Slippers; Socks; Stockings; Undergarments; Underwear; Athletic bottoms; Athletic pants; Athletic shorts; Athletic skirts; Athletic sweaters; Athletic tights; Athletic tops; Bustiers; Crew necks; Foundation garments; Garter belts; Hooded sweatshirts; Hoodies; Jackets; Jumpsuits; Lounge pants; Maternity bras; Maternity leggings, namely, leggings featuring built-in maternity bands; Maternity lingerie; Shapewear, namely, girdles, bras, panties, slips, bodysuits, shorts, leggings, corsets, waist cinchers; Shirts; Sports bras; Sports pants; Sweat bands; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Sweat suits; Sweaters; Tank tops; Teddies being underclothing; Tops as clothing; Track jackets; Warm-up suits; Yoga pants; Yoga shirts; Caps being headwear; Clothing, namely, maternity bands; Crop tops; Fleece tops; Halter tops; Jogging pants; Knit tops; Maternity sleepwear; T-shirts; Track pants; Women's athletic tops with built-in bras; Women's tops, namely, camis

Standard Characters

Claimed

Mark

Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 90803422

Filing Date June 30, 2021

Current Basis 1B

Original Filing 1B